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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,944	02/10/2000	Srinivasan Venkatesan	OBC-98	4578

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ENERGY CONVERSION DEVICES, INC.
2956 WATERVIEW DRIVE
ROCHESTER HILLS, MI 48309

EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/501,944

Applicant(s)

VENKATESAN ET AL.

Examiner

Julian Mercado

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached communication.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 5, 11 and 18.Claim(s) rejected: 1, 4, 6, 7, 10, 12, 13, 15 and 17.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

This Advisory action is responsive to applicant's amendment filed December 1, 2003.

Response to Arguments

The amendment has been fully considered but is not deemed to place the application in condition for allowance for the following reasons:

The examiner maintains the present ground(s) of rejection for the reasons of record. Applicant submits that "Ikoma provides no teaching or suggestion of a pectin binder" and that "Bougauchi uses a pectin binder in a zinc electrode but provides no teaching or suggestion that the pectin binder may be used in combination with a nickel hydroxide material". (response page 6, emphasis as submitted) These arguments are not persuasive as they merely address the salient teachings of Ikoma et al. and Bougauchi et al. and not the combination as a whole, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of Ikoma et al. and Bougauchi et al. is maintained to teach or at least suggest the claimed invention insofar as Ikoma et al. teaching a positive electrode employing a nickel hydroxide active material and Bougauchi et al. teaching pectin as a binder for an electrode.

Applicant submits that since the zinc electrode in Bougauchi et al. is typically used as a negative electrode, combining Bougauchi et al.'s pectin in Ikoma et al.'s positive electrode is improper. In reply, the examiner asserts the following which forms the basis for a proper

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combination: Ikoma et al. specifically teaches the addition of zinc to the positive electrode as a paste material, see col. 4 line 52-56:

A positive electrode was produced in the following manner. A spherical nickel hydroxide powder, cobalt powder, cobalt hydroxide powder and zinc oxide powder were mixed at a weight ratio of 100:7:5:2 and water was added to the mixture to obtain a paste. This paste

As discussed previously, Bougauchi et al. specifically teaches pectin as a binder, “[p]ectin is used to the binder consisting of Zn oxide powder and Zn powder or a simple substance of Zn powder, and thereby a paste with good fluidity is obtained.” (Abstract under ‘CONSTITUTION’) In other words, Bougauchi et al. teaches an improved paste fluidity from the addition of pectin to an electrode binder. Thus, it is maintained that the skilled artisan would be motivated to modify the teachings of Ikoma et al. in view of Bougauchi et al. for reasons such as improving the fluidity of the *zinc paste* employed by Ikoma et al. by employing a *pectin/zinc paste* of Bougauchi et al. (emphasis added to highlight that both patentees teach a zinc paste material) The motivation for such a combination would be to enhance the mechanical strength of the formed electrode. (as taught by Bougauchi et al., Abstract) While the examiner concedes that Bougauchi et al.’s stand-alone disclosure may be drawn to addition of the pectin/zinc paste to the negative electrode, in the combined teachings of Ikoma et al. in view of Bougauchi et al. there is a reasonable expectation of success that the pectin/zinc paste would result in improved fluidity, etc. in the positive electrode of Ikoma et al., especially in view of both Ikoma et al. and Bougauchi et al. teaching the addition of a zinc paste to the positive electrode.

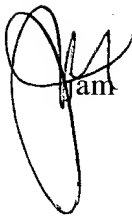
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



am



Patrick Ryan
Supervisory Patent Examiner
Technology Center 1745